UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,655	02/25/2005	Kouichi Nakaoji	SAEG180.001APC	7988

20995 7590 11/13/2007

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER	
CLARK, AMY LYNN	

ART UNIT	PAPER NUMBER
1655	

NOTIFICATION DATE	DELIVERY MODE
11/13/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary	Application No.	Applicant(s)	
	10/525,655	NAKAOJI ET AL.	
	Examiner	Art Unit	
	Amy L. Clark	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 August 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgment is made of the receipt and entry of the amendment filed on 28 August 2007 with the cancellation of claims 1-21, and newly added claims 22-29.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 22-29 are under examination.

Claim Objections

Claims 23, 25 and 26 are objected to because of the following informalities: Claim 23 recites the following species: "*Orthosiphon aristatus*", "*Orthosiphon spicatus*", and "*Orthosiphon stamineus*". However, it should be noted that these species are synonyms of each other and "cat's whiskers" and are, therefore, redundant. Applicant should amend the claim to demonstrate that these species are all alternative names for "cat's whiskers" rather than the way it is written now, wherein it appears that these species are distinct from each other and from "cat's whiskers". Please insert the plant between "extracting" and "with a solvent" in line 2 of claim 25. Please insert a between "of" and "soft drink" in line 2 of claim 26 Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Newly applied as necessitated by amendment.

The metes and bounds of Claim 24 are rendered uncertain by the phrase "comprising 0.1 to 100g, calculated as dry plant, of the plant or extract thereof" because the amounts of the ingredients are not set forth in terms of either 'by weight" or "by volume" amount of the total composition. Does Applicant mean that the dried plant, the plant itself or the extract is in a total weight of 0.1 to 100 g? If so, then what is this in relation to? Is it in relation to the amount added to a composition, or in relation to other ingredients in a composition or something else? There is no basis of comparison for the weight, so it is difficult to tell what Applicant is intending by stating a weight with no relationship to anything. Furthermore, it is unclear as to what Applicant means by "calculated as dried plant, of the plant or extract thereof". Is Applicant saying that the total weight is in relation to a dried plant, a whole plant or an extract? Also, what part of the plant is Applicant directing "dried plant", "of the plant" and "extract thereof" to? Is Applicant referring to the whole plant or a specific part? What distinguishes a "dried plant" and "extract thereof" from "of the plant"? The lack of clarity renders the claims indefinite since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 22-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe (N, JP 60-197627 A, Translation of abstract only provided herein). Newly applied as necessitated by amendment.

Watanabe teaches an herbal tea obtained from kumis kuching (*Orthosiphon stamineus* Bentham, which is synonymous with cat's whiskers and *Orthosiphon aristatus* (Blume) Miq.), wherein the kumis kuching is extracted with water, aqueous organic solvent, or ethanol, which reads on liquid form and at least one additional edible ingredient. Watanabe teaches that the extract is then concentrated. Watanabe teaches that the aqueous, aqueous organic or ethanol extract may by desalted, concentrated, freeze-dried and formed into powder or granules, that vitamins, flavorings and/or seasonings may be added, which reads on at least one additional edible ingredient, powdered form, powder, granule, solid mass in claims 26-28. Watanabe further teaches a specific example of obtaining the edible herbal tea comprising boiling 200 grams of dried kumis kuching leaves in 10 liters of water for five minutes, filtering to give a crude extract that was then purified (See page 2), which reads on 0.1 to 100 grams calculated as dried plant, of the plant or extract thereof in claim 24.

It is noted that the reference does not teach that the composition can be used in the manner instantly claimed, however, the intended use of the claimed composition does not patentably distinguish the composition, *per se*, since such undisclosed use is

inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

"[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also MPEP § 2112.01 with regard to inherency and product-by-process claims.

Please also note that Watanabe teaches Applicant's claimed composition and teaches that cat's whiskers is present in the composition in the amount as claimed by Applicant in claim 24; therefore, it does not matter if the intended use is the same with regards to claim 24 since the amounts taught by Watanabe are one and the same as the amounts claimed by Applicant.

Therefore, the reference anticipates the claimed subject matter.

Response to Arguments

Claim Rejections - 35 USC § 112

Applicant's arguments, see "Applicant Arguments/Remarks Made in an Amendment", filed 28 August 2007, with respect to the rejection of claims 1, 2, 4 and 5 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection of claims 1, 2, 4 and 5 under 35 U.S.C. 112, second paragraph has been withdrawn.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's arguments, see "Applicant Arguments/Remarks Made in an Amendment", filed 28 August 2007, with respect to the rejection of claims 1, 2, 4 and 5 under 35 U.S.C. 102(b) as being anticipated by Nakaguchi et al. (O*, JP 2001-031528 A) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made of newly submitted claims 22-29 under 35 U.S.C. 102(b) as being anticipated by Watanabe (N, JP 60-197627 A, Translation of abstract only provided herein).

No claims are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy L. Clark whose telephone number is (571) 272-1310. The examiner can normally be reached on 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amy L. Clark
AU 1655

Amy L. Clark
October 26, 2007

Michele C. Flood.
MICHELE FLOOD
PRIMARY EXAMINER